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EXAMINER	
NGUYEN, CUONG H	
ART UNIT	PAPER NUMBER
3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/329,461	Rodriguez et al..
Examiner	**Art Unit**
Cuong H. Nguyen	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 17, 2002* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-14 and 25-46* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14 and 25-46* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1. This Office Action is the answer to the response received on 5/17/2002, which paper has been placed of record in the file.

2. Claims **1-14, 25-46** are pending in this application.

Response to the paper submitted on 5/17/2002:

3. The previous Final Rejection is withdrawn based on a request for reconsideration. In response to that, the examiner shows his position when interpreting given cited references as explaining below. At first, the examiner submits that smart-card has been widely used in transactions, it can do all limitations in pending claims. MS Computer Dictionary (3rd edition, 1997) defines that a smart card is a circuit board with built-in logic or firmware that gives it some kind of independent decision-making ability; or a credit card that contains an integrated circuit that gives it a limited amount of "intelligent" and memory. Therefore, smart-card's abilities at the time of invention having all claimed abilities.

4. During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in

this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

And in ***Merck & Co. Inc. v. Biocraft Laboratories Inc.,*** 10 USPQ2d 1843 (CA FC 1989), the court ruled: A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments (e.g., applicant argues that "inventory" terms not on cited references; but this is obvious in **Tognazzini**'s field of application).

5. The examiner further submits published evidences from a commercial database of Dialog Classic showing that the claimed subject matters were already in public knowledge before the invention priority date of 6/10/1999:

A. From Dialog® File 348, "Method and apparatus for creating and storing secure customer receipts on smart cards.", (US Pat. Application of Stephen John Chasko #149917 filed on 9/09/1998; wherein it discloses a system for creating, storing and retrieving secure transaction receipts. These transaction receipts may be stored on portable electronic media that can be carried by a consumer. Each transaction record contains information detailing the product purchased, merchant and customer 's Ids and an encrypted signature; examples of suitable portable storage media are personal computer diskettes, magnetic stripe cards or smart cards. The secure electronic transaction receipts may be used as substitutes for paper receipts; and the

portable electronic media is capable of storing a large plurality of such transaction records.

B. From Dialog® File 347, "Electronic receipt filing card and device for performing access to this card.", (JP Pat. 08-202774 to Kobayashi Takafumi filed on 1/20/1995; wherein it discloses the use of an e-receipt for accounts processing in place of the paper receipt by providing e-receipt filing card, for which receipt data are electronically recorded in a card so that propriety of data can be checked.

C. From Dialog® File 347, "Telecommunication and remote control device with a chip card unit, same device with a coupled computer for Internet applications.", (WO Pat. 9857510 to Gerhard Wiehler, with priority date 6/12/1997; wherein it discloses a chip card unit's applications include mutual; client-server authentication, verification of access rights, digital signature for sensitive data, generation of keys to encrypt data, proof of ordering, payment from an electronic purse.

D. From Dialog® File 15, "Coming soon to a computer near you: Secure cyber shopping.", by Steve Mott of Credit World, v85n5 pp:24-27 May/June 1997; wherein it discloses that a customer receives an electronic "wallet" containing digital certificates that verify a customer's identity, and upon validating and authorizing process, that customer gets a digital receipt of the transaction for his/her records.

E. From Dialog® File 15, "Direct marketing: Rise and rise or rise and fall?", by Evan Martine et al., in Marketing

Intelligence & Planning v13n6 pp:16-23 1995; wherein it discloses that the latest development in EpoS and electronic funds transfer at point of sale systems enable retailers to record purchasing patterns. Smart cards were introduced on which vast amounts of personal/secured information can be stored.

F. From Dialog® File 16, "Electronic commerce: It's all a matter of trust.", by David Woolford of Computing Canada, v25 n18, p.13(1), published on 5/07/1999; wherein encryption, digital signatures, and authorizations have been used to verify receipts.

G. From Dialog® File 350, "Security system for data transmission in electronic payment transactions - has receipt information registered in electronic form in smart card processes." By Lewke, K., (a DE patent 19634418 with priority date of 8/26/1996) ; wherein it discloses that the use of a card in a terminal results in an e-receipt being generated based on the data stored in the chip of the card; and a security system for use with data transmission and handling in electronic financial transactions that use smart data cards in electronic payment systems.

H. From Dialog® File 350, "Electronic wallet for use over mobile telephone system - has mobile telephone accepting smart card that operates with mobile to transfer money...", by Jonstroemer, U. (US Pat. 6,142,369 with priority date of 10/14/1997; wherein this patent discloses a payment system uses a smart card and a telephone system; the receipt of

money is shown on the till display and the till can return an e-receipt with encryption systems are used to provide security.

I. From Dialog® File 636, "Successful online payments strategies.", Electronic Payments International, published on 5/28/1999; wherein it discloses that smart cards can perform the role of carrying multiple payments instruments such as credit, debit, e-cash .etc. these can serve as a repository for e-receipt, transactional information and historical payments data; smart cards also perform authenticating the validity of the user and the instrument, getting the transaction authorized for valid funds, recording payment details, and confirming the transaction.

J. From Dialog® File 636/9, "NETS launches e-billing service for Singapore 11/16/1998.", Newsbytes, published on 11/16/1998; wherein it discloses that customers confirm their identities on the Web site by the use of a smart card; the transaction is then encrypted and sent electronically to the bank for processing and confirmation and records are stored on the Web for reference by the customer as a receipt.

K. From Dialog® File 349, "An electronic-receipt service." By Scott T. Alan et al., (US Patent Application: 99137575 filed on 6/04/1999); wherein it discloses a web-based transaction data storage and retrieval providing retailers the operational cost savings of electronic signature

capture; this system also recreates receipts as proof of a transaction.

L. From Dialog® File 9, "The card of the future (The smart card promises to change the nature of travel, acting as a ticket, credit card, and wallet.", Travel Agent, v284, n 2, p 62, printed on 11/18/1996; wherein it discloses the use of a smart card that is outfitted with a computer chip that can keep track of all travel transactions and receipts. The card will also serve as an "electronic purse" taking the place of cash; smart cards are microprocessor-based cards with storage and processing capabilities.

M. From Dialog® File 15, "Ending the paper chase: Applying electronic data interchange.", by Michael D. Phillipus published on 4/1998, in Risk Management, v45n4 pp:37-40; wherein it discloses the use of electronic digital signatures in electronic records.

N. From Dialog® File 16/636, "Changing dynamics in the global game.", Card International, published on 6/09/1999; wherein electronic receipts for purchase has been used with smart-card/e-wallet technology with enhanced memory and processing capabilities to adequately fulfill transactions' requirements like authentication and certification.

O. From Dialog® File 636, "Changing dynamics in the global game.", Card International, published on 6/09/1999; wherein electronic receipts for purchase has been used with smart-card/e-wallet technology with enhanced memory and processing

capabilities to adequately fulfill transactions' requirements like authentication and certification.

P. From Dialog® File 636, "Changing dynamics in the global game.", Card International, published on 6/09/1999; wherein electronic receipts for purchase has been used with smart-card/e-wallet technology with enhanced memory and processing capabilities to adequately fulfill transactions' requirements like authentication and certification.

Q. From Dialog® File 636, "Changing dynamics in the global game.", Card International, published on 6/09/1999; wherein electronic receipts for purchase has been used with smart-card/e-wallet technology with enhanced memory and processing capabilities to adequately fulfill transactions' requirements like authentication and certification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **1-14, 25-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tognazzini** (US Pat. 5,739,512), in view of the Official Notice.

A. Re. To claim 1: **Tognazzini** suggests a method for conducting a commercial transaction in a distributed data processing system, the method comprising the steps of:
- recording an electronic receipt **(a digital certificate)** on a removable storage medium (a smart card, see **Tognazzini**, the abstract, Fig.6A, 7, 1:47-55, 2:26-28) at a first data processing terminal, the electronic receipt **(a digital certificate)** comprising data concerning a commercial transaction (not patentable);
- receiving the removable storage medium (a smart-card) at a 2nd computer at a different time; (see **Tognazzini**, Figs.1-2, 6A, 7, 3:16-20; this limitation is not patentable);

The examiner submits that **Tognazzini** performs validating an e-receipt stored on the removable storage medium/(a smart-card) at the second computer; (see also **Tognazzini** for an analogous step of "sending an e-confirmation of the purchase transaction to a customer", 3:21-26) not patentable);and

The examiner submits that **Tognazzini** performs checking digital signatures (validating/integrity determining e-receipt) to conducting a commercial transaction (see **Tognazzini**, the abstract, Figs.4, 7).

The examiner also submits that a validated e-receipt can be in the form of a digital certificate just because a document is validated; therefore the Official Notice is taken that a reference from http://www.findarticles.com inherently suggests said "validation":

See Business Wire - August 26, 1998, VeriSign and Gemplus Expand Strategic Relationship; To Develop Joint Smart Card/Digital Certificate Solution For Secure Network Applications.

B. Re. To claim **2** (as claim 4): The method of claim 1 wherein the step of validating the electronic receipt **further** comprises inspecting a digital signature. This limitation is similar to an obvious step done by **Tognazzini** "Encryption techniques permit the secure transmission of electronic information. Well-known public/private key encryption schemes provides privacy and content security, while digital signature schemes provide for authentication of the sender. These techniques are well-understood and widely used in many applications, including electronic mail and EDI.". Therefore, this limitation is not patentable.

C. Re. To claim **3** (as claims 1, 5): Besides having several limitations as claims 1,5; this claim further discloses limitations that **Tognazzini** suggests:

- in response to validating an e-receipt (this whole feature can be intepreted as "then..."),

a. providing an indication to proceed with a delivery of goods/services related to the purchase transaction (see **Tognazzini** 2:28-40; and

b. updating an inventory affected by said delivery of goods/services (see **Tognazzini** 6:62-65, 2:61-65 ("process information...produce a report summarizing ... some of the

receipts"), 3:4-20 ("process information...produce a report summarizing ... some of the receiptslll to process receipt information into a report summarizing purchase transactions"), 3:28-38 (processing purchase transactions ...containing information about accounts...)) (this updating step merely a well-known step in marketing business resulting from orders).

The examiner submits that all claimed limitations are so obvious or well-known in the art, one reason is because these claimed limitations are very broad that they are easily recognized by artisan in the art to be ability/features/components of a computer system/(software program) and said components/features would perform claimed tasks/steps; cited prior art's limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for communicating between sellers and buyers through e-receipts as a convenient way, paperless transaction, improving accuracy by using past history and security techniques. It is reasonable that various modifications and variations of the described method or system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited disclosures have been described in connection with specific preferred embodiments, it should be understood that their subject matters should not be limited to such specific disclosures.

D. Re. To claim **4** (as claim 2): The method of claim 3 wherein the step of validating the e-receipt further comprises inspecting a digital signature to verify the integrity of the electronic receipt. The Official Notice is taken here that a step of inspecting a digital signature has been known. One of ordinary skill in the art would perform said inspection step as inspecting a digital signature gives proof for a document.

E. Re. To claim **5** (as claim 1): Besides several similar limitations in claim 1, the Official Notice is taken that the following limitations are known:

- in response to validating the electronic receipt, providing an indication to proceed (can be a "Y"/"O.K." signal to continue/follow to next step in business which is well-known: delivery of goods) with a delivery of goods/services related to a purchase transaction.

F. Re. To claim **6** (as claims 3, 5): The method of claim 5 further comprising:

- processing a purchase transaction (as claim 3);
- generating an e-receipt comprising data concerning the purchase transaction (as claim 3); and
- storing the electronic receipt on said removable storage medium (as claim 3);

wherein said removable storage medium remains with a consumer (this limitation is not patentable since "remains with a consumer" is an option, the point is "an e-receipt storing in a smart-card").

Therefore, the rationales for rejection of claims 3, 5 are applied.

G. Re. To claim 7: The method of claim 5 further comprising: - said removable storage medium **remains with a consumer;** this limitation is already discussed in claim 6; therefore similar rationales and references are applied.

H. Re. To claim 8: The method of claim 5 further comprising: - prior to validating the e-receipt, selecting one of e-receipts in accordance with input from a consumer.

The Official Notice is taken that a step of selecting a specific receipt for validating must be made because there were different e-receipts in a storage device. Therefore, that step is obvious in said method.

I. Re. To claim 9: The method of claim 5 wherein the e-receipt may be validated a number of times for a purchase transaction that requires a plurality of deliveries of goods/service (the use of "may be" means a possibility/option; it can be interpreted as "at least once". However, the Official Notice is taken here that if there are many validations the step of validating a receipt is still obvious (e.g., a purchased device having several different components: an amplifier set, a DVD/DC player, surround sound speakers .etc. if the store is missing a speaker, then the purchase is still went thru. With a later pick-up of that missing speaker; when a customer picks-up that missing speaker, another validating of e-receipt must be made).

J. Re. To claim **10/11**: The method of claim 5 wherein the e-receipt "may be" validated for a claim for servicing of a product subject to the purchase transaction.

The Official Notice is taken that for the purpose of later servicing a product, original receipt must be provided whether it is a regular receipt or an e-receipt; therefore, this limitation is obvious to one of skill in the art.

K. Re. To claim **11** (as claim 10): The method of claim 5 wherein the e-receipt may be validated **for** a warranty claim on goods/services subject to the purchase transaction. The examiner submits a similar rationale as for claim 10.

L. Re. To claim **12/29**: The method of claim 5 wherein the removable storage medium is a smart card.

The examiner submits that a smart card (i.e., a credit card that contains an IC circuit that gives it a limited amount of "intelligent" and memory) or a floppy disk or a safe card are obviously classified as removable storage medium.

M. Re. To claim **13**: The method of claim 5 wherein the removable storage medium is an optical card.

The examiner submits that an optical card (i.e., a compact disk) or a floppy disk are already classified as a removable storage medium in computer industry.

N. Re. To claims **14/26**: The method of claim 5 wherein the step of validating the electronic receipt further comprises inspecting a digital signature to verify the integrity of that e-receipt

The examiner submits that a step of validating/checking/(verifying the integrity) obviously may means inspecting a digital signature of said document because that is one of requirements).

The examiner submits similar rationale for claim 26 although it claims a program product.

O. Re. To claims **15-24**: These claims were canceled on 9/14/2001.

P. Re. To claim **25**: A computer program product in a computer-readable medium for conducting a commercial transaction, the computer program product comprising:

- 1st instructions for recording an e-receipt on a removable storage medium at a 1st computer, the e-receipt comprising data concerning a commercial transaction (obvious limitation - not inventive);
- 2nd instructions for reading the removable storage medium after its receipt at a 2nd computer (obvious limitation - not inventive);
- 3rd instructions for validating the e-receipt stored on the removable storage medium at the 2nd computer (obvious limitation - not inventive); and
- 4th instructions for providing authorization for conducting a commercial transaction in response to validating the e-receipt (obvious limitation - not inventive).

The examiner submits similar rationales as in claim 1 although it claims a program product and similar rationales and references for rejection are applied.

Q. Re. To claim **26** (as claims 4, 14): The computer program product of claim 25 wherein the instructions for validating the electronic receipt further comprise instructions for inspecting a digital signature to verify the integrity of the electronic receipt. The examiner submits that instruction for validating an e-receipt analogous to inspecting a signature.

The examiner submits similar rationales and references as in claim 4 for rejection are applied although it claims a program product.

R. Re. To claim **27/37**: A computer program product in a computer-readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;
- 2nd instructions for generating an e-receipt comprising data concerning the purchase transaction;
- 3rd instructions for storing the e-receipt on a removable storage medium;
- 4th instructions for reading the e-receipt on the removable storage medium;
- 5th instructions for validating the e-receipt; and
- 6th instructions for providing an indication to proceed with a delivery of goods/services related to the purchase

transaction in response to validating the electronic receipt.

Besides similar limitations with claim 27; claim 37 further having:

- 7th instructions for updating an inventory in response to validating the e-receipt.

This claim 's limitations are obvious by analogy to the limitations of claims 3/5. Therefore, similar rationales and references for rejection from those claims are applied.

S. Re. To claim **28**: The computer program product of claim 27 wherein the instructions for validating the e-receipt further comprise instructions for inspecting a digital signature to verify the integrity of that e-receipt.

This claim 's limitations are obvious by analogy to the limitations of claim 4. Therefore, similar rationales and references for rejection are applied. It 's obvious to suggest this idea in a computer-readable medium.

T. Re. To claim **29** (as claim 12): The method of claim 1, wherein said removable storage media is a safe card, The examiner submits that a smart card can be considered as a safe card; therefore, Therefore, similar rationales and references using in claim 12 for rejection are applied.

U. Re. To claim **30**: (as claim 12): The method of claim 1, wherein said removable storage media is a smart card (similar rationales and references using in claim 12 for rejection are applied).

V. Re. To claim **31**: The method of claim 1, wherein each portion of said removable media can only be written once. The examiner submits that the ability to write on the track of a media only one time have been widely used in industry; e.g., in electronic communications have been widely used PROM (programmable read-only-memory) chips, wherein that memory media is only been programmed once and cannot be reprogrammed. Therefore, it is obvious to one with skill in the art to choose available removable media only able to be written once.

X. Re. To claim **32/5**: The method of claim 1, wherein said reading step is performed to delivery of goods/services previously paid for. The examiner submits that this claimed step (reading a store's receipt) has been done and it is not patentable.

Y. Re. To claim **33/5**: The method of claim 1, wherein that reading step is performed to verify warranty granted. The examiner submits that this claimed step (reading a store's receipt) has been done and it is not patentable.

Z. Re. To claim **34**: A method of processing a receipt, comprising the steps of:

- conducting a new transaction which is affected by said previous transaction (e.g., exchanging a previously purchased TV);

- updating said 1st e-receipt to reflect said new transaction. The examiner submits that updating a receipt has been widely practiced in marketing. Therefore, instead of a regular receipt, an e-receipt takes place knowing that e-receipt existed before the time of this pending invention (see cited references). This claim is not patentable.

35.Re. To claim **35**: The method of claim 34, wherein said updating step overwrites said 1st e-receipt and writes a 2nd, updated e-receipt. The examiner submits that this fundamental step to updating a receipt has been widely used in business; therefore, this step is not inventive in computer applications.

36.Re. To claim **36**: The method of claim 34, wherein said updating step writes a 2nd e-receipt reflecting said new transaction and places a pointer in said 1st e-receipt which points to said 2nd e-receipt. The examiner submits that the MS Computer Dictionary (3rd edition, 1997) did defines a use of a pointer; pointer: a variable that contains the memory location (address) of some data rather than data itself; therefore the above step for updating e-receipt using pointer was self-explained before the pending invention date. The above method step is not patentable.

37.Re. To claim **37**: A computer program product in a computer readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;

- 2nd instructions for generating a 1st e-receipt comprising data concerning the purchase transaction;
- 3rd instructions for storing said 1st e-receipt on a removable storage medium;
- 4th instructions for reading said 1st e-receipt from the removable storage medium;
- 5th instructions validating said 1st e-receipt; and
- 6th instructions for modifying said 1st e-receipt.

The examiner submits that it was obvious to one with programming skill in the art to write above instructions using rationales and references of claim 27. The above program product is not patentable.

W. Re. To claim **38**: The computer program product of claim 37, wherein said 6th instructions **overwrite** said 1st e-receipt and write a 2nd, updated e-receipt. The examiner submits that this step has been widely used in business for updating a receipt; e.g., a customer brought back a product to exchange for a different product within an allowable exchange period; then the salesman issued an updated receipt. The above feature is not patentable.

AA. Re. To claim **39**: The computer program product of claim 37, wherein said 6th instructions **write a 2nd e-receipt** reflecting said new transaction and places a pointer in said 1st e-receipt which points to said 2nd e-receipt. The examiner submits that this step is analogous to putting a remark (in 1st receipt) to remind a relationship between 1st & 2nd receipts; the use of a pointer to do this task has

been known to one with programming skill in the art. The claimed feature is not patentable.

AB. Re. To claim **40** (same as in claim **6**): The method of processing a receipt, comprising the steps of:

- storing an e-receipt for said commercial transaction on a computer-readable media (e.g., smart-cards), wherein said e-receipt contains additional information beyond that given to document the transaction (e.g., those additional info. can be type, model, year made, serial number of a product; these above information are well-known for one with skill in the art); and
- giving said computer readable media to a customer; this limitation is obvious with above rationales. The claimed feature is not patentable.

AC. Re. To claim **41**: The method of claim 40, wherein said additional info. is a credit card number which causes an extended warranty to be in effect. This step has been analogously used in business: if you buy an air ticket and use your credit card, the credit card company also covered for the life insurance of you in case there is an accident for you that happening in that flight. This limitation is not patentable.

AD. Re. To claim **42**: The method of claim 40, wherein said additional information is installation guidelines for a product purchased in said commercial transaction; e.g., when a customer buy a satellite disk, and a self-installation instruction booklet would be provided and this info. has

been considered as booklets was provided and written in a receipt as evident; because of this reasoning the examiner submits that this limitation is not patentable.

AE. Re. To claim **43**: A computer program product in a computer-readable medium for processing an e-receipt, the computer program product comprising:

- 1st instructions for processing a purchase transaction;
- 2nd instructions for generating an e-receipt comprising data concerning the purchase transaction; and
- 3rd instructions for storing said e-receipt on a removable storage medium (a smart-card) along with **additional information** beyond that given to document the transaction (note: additional information can be interpreted as just information).

The examiner submits that this claim's limitations have been considered in claims 3, 42 and 40; therefore, similar rationales and references for rejections are applied.

AF. Re. To claim **44**: The computer program product of claim 43, wherein said additional information is a credit card number which causes an extended warranty to be in effect. The examiner submits that similar rationale and references for rejecting claims 41 are applied.

AG. Re. To claim **46**: The examiner submits that besides limitations as in claim 27, the data stored is in encrypted form.

The Official Notice is taken here that above analogous feature has been done.

AH. Re. To claim **45**: The examiner submits that besides limitations as in claim 27, the data stored is in encrypted form although claim 45 is a method claim.

And "whereby consumer tampering with said receipt is prevented" the examiner submits that it is very obvious that "consumer tampering with said receipt is prevented" from encryption already; therefore, this limitation is not patentable.

In summary, all the claims are directed to the use of e-receipt stored on a computer-readable medium (smart-card) for transactions wherein all claims' limitations can be found in the US patents of **Tognazzini** (US Pat. 5,739,512), **Vaghi** (US Pat. 6,047,273), **Beatson** et al., (US Pat. 5,892,824), and **Muftic** (US Pat. 5,850,442), or very obvious with capacities of smart-cards at the time of invention. In the cited disclosures, the inventors or writers utilized e-receipts and did validating them for different purposes.

The Official Notice is further taken here that these concepts are also notorious well-known in the art:

- processing steps for processing a transaction (this processing must be involved in all transaction; therefore, this step is very obvious i.e., **Tognazzini** suggests this step);
- generating steps for generating e-receipts for above transaction;
- storing steps for storing said e-receipts;
- reading steps for reading said e-receipts;

- validating steps for validating said e-receipts;
- indicating steps for providing an indication to proceed (a transaction) with a delivery of related goods/services;
- inspecting steps for inspecting a digital signature of said e-receipts.

The examiner submits that all claimed limitations are so obvious or well-known in the art, one reason is because these claimed limitations are very broad that they are easily recognized by artisan in the art to be ability/features/components of a computer system/(software program) and said components/features would perform claimed tasks/steps; cited prior art's limitations are not necessary spelled-out exactly claimed languages, because cited prior art is also directed to a similar process/system for communicating between sellers and buyers through e-receipts as a convenient way, paperless transaction, improving accuracy by using past history and security techniques. It is reasonable that various modifications and variations of the described method or system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although cited disclosures have been described in connection with specific preferred embodiments, it should be understood that their subject matters should not be limited to such specific disclosures.

Conclusion

7. All pending claims are rejected.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. These references are also considered pertinent to this application:

- Business Wire, Feb 11, 1999; RPK Security Selected to Provide Encryption Solution for Electronic Payment Systems and Smart Card Readers. (claim 46)

- Digital signature reaches new level.(Bank of Nova Scotia uses Entrust Technologies' public key infrastructure software) (Company Operations); Author/s: Greg Meckbach. Issue: June 22, 1998.

- **Trotta**, Jr., (US Pat. 5,595,264), System and method for automated shopping - 1/21/1997; wherein a system and method

of automated shopping, including a portable bar code scanner for scanning bar code indicia information on items selected to be purchased, securing the scanner in a holder for limited access, and releasing the portable bar code scanner upon receiving an authorized payment card. A plurality of items for purchase are displayed in a store such that a customer can select an item to be purchased from the store display. The customer scans the bar code indicia on the selected item from the store display. The payment card is debited for the purchase price of the selected item and then returned to the customer.

- **Kitagawa** et al. (US Pat. 6,032,857 - 8/23/1994) Electronic money system wherein an electronic money system has an IC card for electronic money having a memory for maintaining money deposit and money debit information and another memory, such as an EPROM, for storing transaction data, including detailed information of transactions, such as the content of a typical receipt received from a retail store. The transaction information can be used at a later time in a personal computer so that an electronic record of household expenses can be maintained The transaction data that is stored includes the product name, price of the product, quantity of the product purchased and similar details of the transaction. The IC card memory can record the name and telephone number of a retail store where the card has been

used or a network address can be recorded in the memory for use by a customer to access electronic direct-mail information by using a PC. Also, a store can determine whether a particular purchase is within a range of average purchases in terms of the number of products being purchased in a transaction and the total cost of the transaction, based on the stored transaction information.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong H. Nguyen whose telephone number is 703-305-4553 The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703)305-7687 [Official communications; including After Final communications labeled "Box AF"]

703-746-5572 (RightFax) Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Cuong Nguyen
Primary Examiner
August 05, 2002